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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/658,381 | 09/10/2003 | Kiyoshi Miyake | S0529.0006 | 3331 |

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| EXAMINER | |
|---|---|
| STRAIGHTIFF, MICHAEL PAUL | |
| **ART UNIT** | **PAPER NUMBER** |
| 3739 | |

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/658,381 | MIYAKE, KIYOSHI | |
| | Examiner | Art Unit | |
| | Michael P. Straightiff | 3739 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *10 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *09/10/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

2. Applicant is reminded of the proper content of an ABSTRACT of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. The abstract of the disclosure is objected to because it is not a concise statement of the technical disclosure and does not generally disclose the subject matter.

Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities:

Page 7, Line 10 of the Specification reads "or may be leaned by" and should read -- or may be learned by --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-6, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,373,317 to Salvati et al. in view of U.S. Patent No. 5,928,137 to Green.

a. In regard to Claim 1, Salvati et al. disclose "[A]n endoscope apparatus comprising a flexible slender insertion section inserted into a to-be-inspected space, the insertion section having a slender flexible tube portion, a distal portion coupled to the distal end of the flexible tube portion, a bendable portion coupled

to the distal portion and to be bent and a proximal portion coupled to a proximal end of the flexible tube portion" (See Salvati et al., Column 2, Lines 39-43), and "an operation section coupled to a proximal end of the insertion section, the operation section having a grip portion gripped by the operator" (See Salvati et al., Figure 1, Reference 14; See also Column 2, Lines 46-49) "and a bending operation portion which bends the bendable portion" (See Salvati et al., Figure 1, Reference 20; See also Column 1, Lines 27-29). They do not meet the limitation "wherein the insertion section has a treatment instrument channel, the distal portion of the insertion section having a distal open end of the treatment instrument channel, and the proximal portion of the insertion section having a proximal open end of the treatment instrument channel; and the proximal open end of the treatment instrument channel is located on the grip portion". Green teaches "wherein the insertion section has a treatment instrument channel, the distal portion of the insertion section having a distal open end of the treatment instrument channel, and the proximal portion of the insertion section having a proximal open end of the treatment instrument channel; and the proximal open end of the treatment instrument channel is located on the grip portion" (See Green, Figure 8; See also Column 3, Lines 18-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an instrument channel with a proximal end located on the grip portion as taught by Green on the endoscope apparatus disclosed by Salvati et al. in order to successfully view and manipulate the tissue using one device.

b. In regard to Claim 2, Salvati et al. further disclose "wherein the grip portion has a display portion which displays an observation image" (See Salvati et al., Figure 1, Reference 23; See also Column 2, Lines 46-49).

c. In regard to Claim 3, Salvati et al. further disclose "wherein the display portion includes a display panel and a frame supporting the display panel" (See Salvati et al., Figure 2; See also Column 4, Lines 21-24). Green discloses the utility of a manipulative instrument handle arranged proximally to the video display monitor collocated on the handle portion (See Green, Column 1, Line 61 – Column 2, Line 8). The location of the proximal open end of the treatment instrument channel is, therefore, considered an arbitrary design consideration, and pending a statement of criticality, not patentably distinct over the prior art.

d. In regard to Claim 4, the location of the proximal open end of the treatment instrument channel is considered an arbitrary design consideration, and pending a statement of criticality, not patentably distinct over the prior art.

e. In regard to Claim 5, Salvati et al. further disclose "wherein the grip portion has a grip which can be gripped by one hand of the operator" (See Salvati et al., Figure 3; See also Column 2, Lines 25-28).

f. In regard to Claim 6, Salvati et al. further disclose "wherein the grip portion has an upper portion provided with a display portion which displays an observation image" (See Salvati et al., Figure 1). The location of the proximal open end of the treatment instrument channel is considered an arbitrary design

consideration, and pending a statement of criticality, not patentably disctinct over the prior art. (See also Green, Figure 8)

g. In regard to Claim 10, the location of the forceps port is considered an arbitrary design consideration, and pending a statement of criticality, is not patentably disctinct over the prior art.

6. Claims 7-9 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,373,317 to Salvati et al. in view of U.S. Patent No. 5,928,137 to Green as applied to Claim 1 and 5 above and in further view of U.S. Patent Application Publication 2003/0176880 to Long et al.

a. In regard to Claim 7, Salvati et al./Green disclose "[A]n endoscope apparatus" (See Claims 1 and 5 Rejections). They do not meet the limitation "wherein the grip portion has a casing and a forceps-port constructing member, the forceps-port constructing member being coupled to the proximal open end." Long et al. teach "wherein the grip portion has a casing and a forceps constructing member, the forceps-port constructing member being coupled to the proximal open end" (See Long et al., Paragraph [0038], Lines 2-8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a "forceps-port constructing member" as taught by Long et al. as a component of the endoscope apparatus disclosed by Salvati et al./Green in order to provide for introduction of instruments while still providing a seal member.

b. In regard to Claim 8, Long et al. further discloses "wherein the forceps-port constructing member is located at a position at which the forceps-port constructing member does not interfere with an operation of the bending operation portion" (See Long et al., Figure 1).

c. In regard to Claim 9, Long et al. further discloses "wherein the forceps-port constructing member is located near the display portion and the bending portion" (See Long et al., Figure 1).

d. In regard to Claim 11, Long et al. further discloses "wherein the grip portion has a downwardly opening forceps port formed in a lower end of the casing" (See Long et al., Figure 1).

e. In regard to Claim 12, Salvati et al./Green disclose "[A]n endoscope apparatus". Salvati et al. does not meet the limitation "wherein the grip portion is detachable from the display portion." Green teaches "wherein the grip portion is detachable from the display portion" (See Green, Column 6, Lines 12-15; See also Column 6, Line 66 – Column 7, Line 10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the combined grip/display portion disclosed by Salvati et al. such that the grip portion is detachable from the display portion as taught by Green in order to enable the device to be autoclaved without damage to the display means, which may not endure high temperatures.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,373,317 to Salvati et al. in view of U.S. Patent No. 5,928,137 to Green as applied to Claim 1 above, and in further view of U.S. Patent Application Publication 2003/0176880 to Long et al. and U.S. Patent No. 6,554,765 to Yarush et al.

a. In regard to Claim 13, Salvati et al./Green disclose "[A]n endoscope apparatus" (See Claim 1 Rejection). They do not meet the limitation "further comprising a universal cord section and a case which can house the insertion section, the universal cord section and the operation section in a wound state." Long et al. teach "further comprising a universal cord section" (See Long et al., Paragraph [0040], Lines 1-7). Yarush et al. teach "a case which can house the insertion section, the universal cord section and the operation section in a wound state" (See Yarush et al., Figure 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a universal cord section as taught by Long et al. and a case as taught by Yarush et al. as components of the endoscope apparatus disclosed by Salvati et al./Green in order to minimize number of cables and to provide a location in which to store the device when not in use.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Straightiff whose telephone number is (703) 308-3620. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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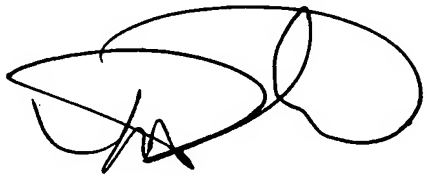

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